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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/070,447 | 03/20/2002 | Hiroyuki Yoshida | 107348-00219 | 7039 |

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ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER

NGUYEN, TU MINH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3748

DATE MAILED: 10/07/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/070,447

Applicant(s)
Yoshida et al.

Examiner
Tu M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 20, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 5 6) ☐ Other:

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DETAILED ACTION

Specification

1. The abstract is objected to because the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.
2. The disclosure is objected to because on page 11, line 13, "engine" should read --oil--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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4. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al. (U.S. Patent 6,053,785).

Re claim 1, as shown in Figure 5, Kato et al. disclose an exhaust passage structure in an outboard engine system, in which at least a portion of an exhaust passage is integrally formed in a case member (15) having a drive shaft (21) accommodated therein for transmitting a driving force from an engine (14) to a propeller (24),

characterized in that openings (78) of the exhaust passage are defined in a sidewall of the case member (15) which is disposed under an engine block (33), and an exhaust passage forming an exhaust silencing portion (78) is defined between the case member (15) and a lid (26) detachably coupled to cover the openings (78).

Re claim 2, as illustrated in Figure 4, in the exhaust passage structure of Kato et al., an oil pan (107) for storing a lubricating oil for the engine (14) is integrally formed within the case member (15).

Re claim 3, as shown in Figure 5, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas,

characterized in that at least a portion of the exhaust passage is integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for transmitting a driving force from the engine (14) to a propeller (24); a connection (78) into which the exhaust passage opens is formed in a side wall of the case member (15); and the

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catalytic converter (83) is disposed in a space surrounded by the case member (15) and a lid (26) detachably coupled to the connection to permit the exhaust gas to flow.

Re claim 4, in the exhaust passage structure of Kato et al., the catalytic converter (83) is supported on the lid (26).

Re claim 5, in the exhaust passage structure of Kato et al., the catalytic converter (83) is supported on the case member (15).

Re claim 6, as shown in Figures 4 and 5, Kato et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (83) for purifying an exhaust gas discharged from an engine (14) is mounted in an exhaust passage for guiding the exhaust gas, characterized in that at least a portion of the exhaust passage and an oil pan (107) for restoring a lubricating oil for the engine (14) are integrally formed in a case member (15) which is disposed under an engine block (33) to accommodate a drive shaft (21) therein for transmitting a driving force from the engine (14) to a propeller (24); a connection (78) into which the exhaust passage opens is formed in a sidewall of the case member (15); and the catalytic converter (83) is disposed in a space surrounded by the case member (15) and a lid (26) detachably coupled to the connection to permit the exhaust gas to flow.

With regard to the preamble directed to a 4-cycle engine, a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie, supra at 480*. See also *Ex parte*

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Mott, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending claim 6 does not rely on the preamble for completeness.

5. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Koishikawa et al. (U.S. Patent 5,554,060).

As shown in Figures 1 and 6, Koishikawa et al. disclose an exhaust passage structure in an outboard engine system in which a catalytic converter (16) for purifying an exhaust gas discharged from an engine (7) is mounted in an exhaust passage for guiding the exhaust gas, characterized in that at least a portion of the exhaust passage and an oil pan (14) for restoring a lubricating oil for the engine (7) are integrally formed in a case member (5) which is disposed under an engine block (18) to accommodate a drive shaft (10) therein for transmitting a driving force from the engine (7) to a propeller (13); a connection (59, 62) into which the exhaust passage opens is formed in a sidewall of the case member (5); and the catalytic converter (16) is disposed in a space surrounded by the case member (5) and a lid (14a) detachably coupled to the connection to permit the exhaust gas to flow.

With regard to the preamble directed to a 4-cycle engine, a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, *supra* at 480. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending claim 6 does not rely on the preamble for completeness.

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Prior Art

6. The IDS (PTO-1449) filed on March 20, 2002 and June 20, 2002 have been considered.

An initialized copy of each is attached hereto.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of five patents: Sougawa et al. (U.S. Patent 5,174,112), Shibata (U.S. Patent 5,239,825), Matsumoto et al. (U.S. Patent 5,595,516), Yoshida et al. (U.S. Patent 5,916,135), and Kato (U.S. Patent Application 2001/0029734), each discloses an exhaust passage structure in an outboard engine system, comprising at least one of an expansion chamber to reduce engine noise, a catalyst, an oil reservoir, and a lid which covers the exhaust passage and supports the catalyst.

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Communication

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (703) 308-2833.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (703) 308-2623. The fax phone number for this group is (703) 308-7763.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

TMN

September 30, 2002

Tu M. Nguyen

Tu M. Nguyen

Patent Examiner

Art Unit 3748

Thomas Denion

THOMAS DENION
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700